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08/411,581 03/29/95 SINOFSKY

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SHAY, D. EXAMINER

33M1/0411

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ART UNIT PAPER NUMBER

3311

DATE MAILED: 04/11/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on March 29, 1995 ☒ This action is made final

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☒ Notice of Draftsman's Patent Drawing Review, PTO-948
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 44-59 are pending in the application  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
- ☒ Claims 1-43 have been cancelled.
- ☐ Claims \_\_\_\_\_ are allowed.
- ☒ Claims 44-59 are rejected.
- ☐ Claims \_\_\_\_\_ are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
- ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

Claims 44-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 10-14 of U.S. Patent No. 4,950,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to omit various unclaimed limitations recited in the patent claims and to include the irrigating or transmitting steps which applicant has discussed as old and well known, thus producing a method such as claimed.

Claims 44-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-20 and 33-35 of U.S. Patent No. 5,196,004. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to omit various unclaimed limitations recited in the patent claims and to include the irrigating or transmitting steps which applicant has discussed as old and well known, thus producing a method such as claimed.

The examiner also notes that substantial double patenting issues exist with regard to the claims of U.S. Application number 07/568,348, filed August 15, 1990.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown

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to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as now claimed.

Applicant has not disclosed the use of liquid or of irrigation or of transmitting fluid to the surgical site.

Claims 44-49 and 53-56 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 47 and 48 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 47 and 48 are indefinite as it is unclear what further method steps are intended to be claimed or implied by the structure recited

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not

identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 44-59 are rejected under 35 U.S.C. § 103 as being unpatentable over Malyshev in view of L'Esperance('541). Malyshev teaches a method of performing a surgical procedure by removing tissue using a wavelength in the claimed range. L'Esperance teaches delivering a fluid to a surgical site and the desirability of using an optical fiber to conduct radiation. It would have been obvious to the artisan of ordinary skill to employ an optical fiber in the device of Malyshev since this yields greater flexibility of manipulation, as taught by L'Esperance and to generate the laser beam using a Ho:YAG or a Ho:YLF laser, since these are known to produce wavelengths in the range disclosed by Malyshev, judicial notice of which is hereby taken and to flush with a liquid, since this is not critical; is a well known flushing medium; and since it can also be used to cool remaining tissues, judicial notice of which is hereby taken, thus producing a device such as claimed.

Applicant has proposed a count. However, since this count includes neither of the limitations which were expressly cited as

rendering the claims of the Boutacoff patents allowable (i.e. that the procedure be endo- or arthroscopic and that the procedure include irrigation of the operating site with liquid), it cannot serve as an interference count for these claims. .

Applicant argues that the claims are patentable to applicant and define the same patentable inventions as the Boutacoff patents. The claims are not patentable to applicant in view of the above rejections and do not define the same patentable invention because the invention resides, at least in part, in the procedure being arthroscopic or endoscopic, neither type of procedure being contemplated by applicant's disclosure.

Applicant argues that support for the claims is discussed in the preliminary amendment. The Examiner notes that the cited passage on page 15 is concerned with providing a fluid (no mention of a liquid is made) to the probe lens tip area. It is the Examiner's perception that applicant has not disclosed performing surgery on the probe lens tip area. Thus, this cannot be considered to be the surgical site and the claim language is not supported by such a recitation.

Applicant then argues that every limitation need not be supported by the instant specification. The Examiner has never disputed this. However, the patentable limitations therein must be supported by the specification as originally filed. The instant disclosure and claims do not support the patentable limitations of an endoscopic or arthroscopic procedure, and thus neither the

claims nor the "proposed count" are supported thereby. Further, the claims and "proposed count" do not define the same patentable invention as claimed by the Boutacoff patents and thus cannot constitute an interference count.

Applicant's arguments that it is not necessary for the Boutacoff disclosures to support each wavelength in the range and that the ranges are not patentably distinct are agreed with.

Applicant's arguments that the steps of irrigating while ablating and maintaining a fluid field do not render the Boutacoff claims patentable is noted, but is not convincing. The amendment that resulted in the first notice of allowability to Boutacoff was to add the irrigating step and as set forth on page 4 of the amendment (paper number 7 of U.S. Application 07/418,942) "the claimed combination of using an infrared laser beam to perform arthroscopic procedures while irrigating the tissue with a fluid medium"(emphasis added). Thus, while the step in and of itself was previously known, the step in combination with the claimed arthroscopic procedure is that which yields patentability. Since the irrigating language is necessary to render the claim allowable, claims not including this step cannot be considered to define the same patentable invention as the claims of Boutacoff. Applicant also argues that because the step of irrigating the surgical site while ablating tissue was known, citing Loeb and Goldenberg, one of ordinary skill would understand that the recitation at page 15 of the originally filed disclosure of delivering fluid to the probe

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lens tip area was meant to teach that the fluid was delivered to the surgical site as well. The Examiner must disagree, and believes that one having ordinary skill in the art would be under the impression that the flushing with fluid was to be restricted to the probe tip to prevent blood or other tissue from contaminating the optical surface of the tip. Therefore, claims 50-52 and 57-59 do not constitute counts against and do not define the same patentable invention as the Boutacoff claims.

An interference has not been initiated because the claims are not patentable to applicant and because the proposed count and the claims do not define the patentable inventions claimed in the Boutacoff patents.

This is a continuation of applicant's earlier application S.N. 08/049,147. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See M.P.E.P. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL

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ACTION.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

D.Shay/pw  
April 10, 1996  
FAX: 703-305-3590



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